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Supreme Court of the United States

OCTOBER TERM, 1959

No. 582 21

ARO MANUFACTURING CO., INC., ET AL.,
PETITIONERS,

v.

CONVERTIBLE TOP REPLACEMENT CO., INC.,
RESPONDENT.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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v.

CONVERTIBLE TOP REPLACEMENT CO., INC.,
RESPONDENT.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

Petitioners, Aro Manufacturing Co., John R. Hamlin, George Shapiro, Harold Shapiro, Mae Shapiro and Marshall Shapiro pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit, entered in the above-entitled case on August 31, 1959.

Citations to Opinions Below

The opinion of the District Court (J.R.A. 33-41)[1] is reported in 119 U.S.P.Q. 122. The opinion of the Court of

[1] The printed materials filed in connection with this petition include two volumes of a Joint Record Appendix containing selected portions

Appeals, printed in Appendix B hereto, *infra*, p. 23, is reported in 270 F.2d 200, 122 U.S.P.Q. 536.

Jurisdiction

The judgment of the Court of Appeals was entered on August 31, 1959. (J.R.A. 635). A petition for rehearing filed September 9, 1959 was denied on September 15, 1959. *Ibid.* The jurisdiction of this Court is invoked under 28 U.S.C. Section 1254 (1).

Questions Presented

The Mackie-Duluk patent in suit relates to an improvement in automatic folding tops for convertible-type automobiles to minimize rain water leakage. Each claim to this improvement recites a combination of a convertible top fabric, supporting structures, and a mechanism for automatically effecting a seal of the fabric against the inside of the automobile body as the top is raised to prevent rain water from entering the interior of the automobile. The convertible top fabric alone is not claimed as an invention in the patent. The Petitioners make, sell and install only convertible top fabrics. The questions presented are:

1. Whether 35 U.S.C. Section 271 (c), which relates to contributory infringement, authorizes the patentee to prevent the sale of one unpatented though

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of the transcript of evidence and other materials in connection with the trial and appeal, including the opinions of the District Court and the Court of Appeals. This Joint Record Appendix is hereafter referred to as J.R.A. These materials also include the printed briefs filed in the court below. The briefs filed by petitioner are referred to as Brief for Appellants and Reply Brief for Appellants. The brief filed by Respondent is referred to as Brief for Appellee.

essential element, the convertible top fabric, of a patented combination when the fabric is especially cut and intended for use in the patented combination.

2. Whether Article I, Section 8 of the Constitution authorizes Congress to enact legislation granting the patentee the right to a limited monopoly over an unpatented component of a patented combination, when intended for use in the patented combination, the unpatented component itself not being an invention.

3. Whether the owner of a convertible automobile purchased from a manufacturer licensed under the patent for a combination infringes the patent by replacing a single worn element, the top fabric, with one made by a replacement top fabric manufacturer who does not pay royalties to the patentee.

4. Whether the patent is misused when the owner of two combination patents covering convertible automobile automatic folding tops assigns a territorial grant limited to Massachusetts under only the patent in suit to a newly-formed corporation just before the latter brings suit while the owner continues to receive royalties under both patents for the sale of fabrics which replace worn unpatented convertible top fabrics.

Constitutional Provision Involved

The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries. U. S. Const. art. 1, § 8.

Statutory Provisions Involved

The statutory provisions involved are 35 U.S.C. Sections 103, 112 and 271 of the Patent Laws and 15 U.S.C. Sections 1-3, 7 and 15 of the Antitrust Laws. 69 Stat. 282 (1955), 26 Stat. 210 (1890), 38 Stat. 731 (1914). They are printed in Appendix A, *infra*, pp. 19-22.

Statement

The Mackie-Duluk Patent No. 2,569,724 in suit was issued on October 2, 1951 to General Motors Corporation. The patent relates to a convertible-type automobile folding top with an improved automatic sealing arrangement to minimize water leakage. Each claim in the patent is to a combination including, a folding bow structure supported on an automobile body, flexible top material supported by the folding bow structure and extending downwardly at the sides toward the rear inside the body where the lower edge of the flexible material is connected, and a wiping arm operatively connected to the folding bow structure so that the wiping arm presses the flexible material into sealing contact with the inside surface of the body as the top is raised. No claim in the patent covers the flexible top material alone. J.R.A. 589-95. General Motors Co. 1950-53 models and Ford Motor Co. 1952-54 models of convertible type automobiles include the improvement claimed in the Mackie-Duluk patent as original equipment. J.R.A. 24.

The flexible top material, or fabric, is usually replaced every three years or oftener; hence, the life of the fabric is several times less than the life of the car. J.R.A. 33. Car manufacturers themselves have little interest in either manufacturing or replacing fabric tops. Consequently, there has grown up a sizeable independent replacement top industry, of which Petitioners are in Massachusetts and per-

haps nationally, leaders. The Petitioners make, sell and install the fabric but do not manufacture, or install, any metal parts, components, or adjuncts. Unlike the fabric, all such metal parts normally last the life of the car. J.R.A. 34.

Respondent Convertible Top Replacement Co. acquired a Massachusetts territorial grant in the Mackie-Duluk patent ten days before bringing suit. J.R.A. 7. Automobile Body Research Corporation, the Respondent's assignor, retained the remaining rights in the Mackie-Duluk patent and also owned the Ackermans patent 2,549,154 (J.R.A. 567-78), also relating to convertible top assemblies, at the time this action commenced. Automobile Body had acquired the Ackermans patent (J.R.A. 617) shortly after being organized following a holding in a suit brought by Ackermans that General Motors was liable for infringing the Ackermans patent.[2]

Several transactions involving the transfer of rights under these patents followed. General Motors assigned the Mackie-Duluk Patent No. 2,569,724 to Automobile Body and retained a royalty free license under this patent. J.R.A. 509. General Motors also agreed to pay Automobile Body royalties under the Ackermans patent for the sale of replacement top fabrics. J.R.A. 31.

Automobile Body signed a license agreement with Ford Motor Co. on July 21, 1955 in which Ford agreed to pay $73,000 for past infringement. J.R.A. 511. Ford also agreed to pay royalties to Automobile Body under both the Ackermans and Mackie-Duluk patents for the sale of replacement top fabrics which "if sold without the patent owner's consent, would constitute contributory infringement ... under 35 United States Code, § 271." *Ibid.*

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[2] *Ackermans v. General Motors Corp.*, 202 F.2d 642 (4th Cir.), *cert. denied*, 345 U.S. 996 (1953) reversed the District Court's finding of lack of invention, 108 F. Supp. 368 (D. Md. 1952).

Later Automobile Body entered into a licensing agreement with Atlas International, a nationally prominent manufacturer of replacement top fabrics, in which Atlas was licensed under both the Ackermans and Mackie-Duluk patents to sell replacement top fabrics on condition that it pay a royalty on the sale of each replacement top for use in 1950-54 General Motors cars, 1952-54 Ford Motor Co. cars and 1953 Chrysler Corporation cars "without regard to whether such top is covered by either of said patents". J.R.A. 617.

Petitioner Aro Manufacturing Co. was first charged with contributory infringement of both patents in a letter dated January 2, 1954 from counsel for Automobile Body. J.R.A. 473. Petitioner Aro changed its fabric construction after consultation with its counsel and refused to accept an offer of a license to sell replacement fabrics. J.R.A. 475-76.

On April 5, 1956 Respondent Convertible Top Replacement Corporation was organized as a Maryland Corporation. On April 17, 1956 Automobile Body assigned Respondent Convertible Top a territorial grant under the Mackie-Duluk patent only, restricted to Massachusetts. J.R.A. 7. Ten days later, on April 27, 1956 Respondent commenced this action. J.R.A. 1. The respective patent counsels of Automobile Body and Respondent Convertible Top are in the same law firm. The jurisdiction of the district court was invoked because a question arises under the Patent Laws.

The District Court found the Mackie-Duluk patent infringed by replacing the top fabrics and contributorily infringed under 35 U.S.C. Section 271(c) by selling fabrics specially cut and intended for use in the patented combination. Although the district court recognized that all General Motors cars licensed under the patent and all Ford Motor Co. cars were licensed after July 21, 1955 (J.R.A. 27), it re-

garded replacing the worn fabric as reconstructing the patented combination. Misuse was not found. J.R.A. 33 n.1.

The Court of Appeals affirmed in an opinion interpreting 35 U.S.C. Section 271(c) without mentioning the Mercoid cases[3] decided by this Court, cases decided in other circuits interpreting Section 271(c), or the legislative history.[4]

In considering whether replacing the worn fabric was an infringement, the Court of Appeals distinguished the *Morgan Envelope* case[5] decided by this Court by saying:

> Since the element replaced by the defendants-appellants was a patented component of the Mackie-Duluk combination, the cases . . . upon which they rely, are not in point, for the elements replaced by the defendant in those cases, the roll of toilet paper and the abrasive stone, respectively, were not patented elements of the devices covered by the patents there in suit. *Infra*, p. 28, n. 2.

The Court of Appeals said that the top fabric itself was covered by the patent. *Infra*, pp. 27-28. While the opinion states that the patentees achieved their objective by devising a patentable *combination* of elements, *infra*, p. 26, it also states that form itself was patentable, *infra*, p. 28, relying on *Wilson* v. *Simpson*, 50 U.S. (9 How.) 109 (1850).

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[3] Mercoid Corp. v. Mid-Continent Inv. Co., 320 U.S. 661 (1944); Mercoid Corp. v. Minneapolis-Honeywell R. Co., 320 U.S. 680 (1944).

[4] The legislative history of the provisions relating to contributory infringement is discussed in the briefs filed in the court below, Brief for Appellants at 48-68; Reply Brief for Appellants at 10-16, and Respondent "does not, in general, take issue with the statements of law set forth in Appellants' brief on appeal . . . Brief for Appellee at 2.

[5] Morgan Envelope Co. v. Albany Paper Co., 152 U.S. 425 (1894).

Reasons for Granting the Writ

1. It is well settled that one directly infringes a patent covering a combination of old elements by selling a device which includes each element recited in any claim of the patent in the same operative relationship. One does not directly infringe if the device sold omits a material element of the patented combination. Contributory infringement was a judicially established doctrine to prevent a seller from avoiding the consequences of infringement by selling in substance the invention, but omitting one of the elements recited in the claims.[6]

The instant case involves the interpretation of the first statutory definition of contributory infringement in the history of the Patent Laws. The statute has been in force since January 1, 1953 and conflicting decisions of lower courts indicate that some courts apparently do not recognize the limited scope of contributory infringement intended by Congress. The interpretation of paragraphs (b), (c) and (d) in 35 U.S.C. Section 271 vitally affects the administration and enforcement of both the Patent Laws and the Antitrust Laws.

The court below appears to have relaxed the statutory requirements for obtaining the monopoly privileges of a patent by interpreting this section to cover the sale of an unpatented element not itself an invention. The decision of the court below appears to be based on the premise that although the top fabrics are not an invention as required by 35 U.S.C. Section 103 and not separately claimed as

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[6] *Wallace* v. *Holmes*, 29 Fed. Cas. 74 (No. 17,100) (D. Conn. 1871) established the doctrine and held that where the patent for a lamp covered a novel burner mechanism supporting a glass chimney, infringement could not be avoided by selling the burner mechanism without the chimney. Congressman Bryson, the sponsor of the bill enacted into Title 35, called contributory infringement the "metaphysics of metaphysics." 98 CONG. REC. A433 (1952).

would appear to be required by 35 U.S.C. Section 112, since they are especially designed and intended for use in the patented combination, selling the top fabrics constitutes contributory infringement under Section 271(c). J.R.A. 38. The apparent importance placed by the court below on the intended use alone is in conflict with cases decided by this Court, other courts of appeal, and the legislative purpose in enacting these provisions as set forth more fully below.

2. Although the constitutional issue was not raised in the courts below nor decided in any other cases within our knowledge, we think that the construction by the court below is unconstitutional because the Constitution provides for granting exclusive rights to the discovery of the inventor; that is, the exclusive or monopoly rights authorized by the Constitution for a limited time are to the invention. The construction by the court below grants limited monopoly rights to the patentee in a part of the combination claimed as the invention.

The constitutional issue was apparently recognized by Mr. Justice Jackson, dissenting in *Mercoid Corp* v. *Mid-Continent Inv. Co.* 320 U.S. 661, 680 (1944) where he said, "I see no constitutional or statutory authority for giving . . . [a combination patent] additional value by bringing into its monopoly all or any of the unpatentable parts."

3. The decision of the court below is in conflict with the *Mercoid* cases[7] decided by this Court before the enactment of 35 U.S.C. Section 271 and also in conflict with the decision of the Eighth Circuit Court of Appeals in *Dr. Salsbury's Laboratories* v. *I. D. Russel Co.*, 212 F.2d 414,

[7] *Supra* n. 3.

cert. denied, 348 U.S. 827 (1954), decided after enactment of the statute.

In the *Mercoid* cases this Court held that a thermostatic switch not separately claimed as an invention but specially designed and intended for use in a patented heating system combination was itself unpatented. Although the switch did not have an actual noninfringing use and was an essential element of the patented combination, it was held not entitled to the privileges of a patent. Thus, exercising monopoly control over the unpatented switches was held to be misuse.

In the *Dr. Salsbury's* case, the sole question was whether 35 U.S.C. 271 had changed the law as to misuse so as to change the result in *I. D. Russell Co.* v. *Dr. Salsbury's Laboratories*, 198 F.2d 473 (8th Cir. 1952) decided on the authority of the *Mercoid* cases. The court held that the newly enacted statute did not change the law of misuse established by the *Mercoid* cases, and the sale of an unpatented chemical sold with instructions to dissolve it in a prescribed amount of water to form the patented combination did not give rise to a cause of action for contributory infringement.

There does not seem to be a logical difference between misusing a patent by trying to prevent the sale of thermostatic switches specially designed for use in the patented combination, the sale of unpatented chemicals packaged with instructions to form the patented combination, and the sale of convertible top fabrics specially designed for use in the patented combination. The thermostatic switch, the chemical, and the top fabric are each only an unpatented, though essential, component part of a patented combination. And none of these component parts themselves are inventions.

Both the Second Circuit Court of Appeals and the Sixth

Circuit Court of Appeals[8] also recognize that the *Mercoid* cases are still the law although the specific factual situations the latter courts considered differ from the case at bar. Thus, the philosophy expressed in these cases is consistent with that of the Eighth Circuit Court of Appeals.

On the other hand, the decisions of the Fourth Circuit Court of Appeals in *Freedman* v. *Friedman*, 242 F.2d 364 (4th Cir., 1957) and the Fifth Circuit Court of Appeals in *Henry Hanger & Display Fixture Corp.* v. *Sel-O-Rak Corp.*, F.2d 123 U.S.P.Q. 3, 7 (5th Cir. 1959) are consistent with the decision below and in conflict with the decisions in the *Mercoid* and *Dr. Salsbury's* cases. The *Freedman* decision allowed the patentee to monopolize the sale of unpatented magnets when intended for use in a patented false teeth assembly. The *Henry Hanger* case allowed a *design* patentee to monopolize an unpatented part of the patented design. Both cases ignored the *Mercoid* decisions.[9]

This Court is urged to resolve the above-described conflicting decisions concerning contributory infringement under 35 U.S.C. Section 271 with an interpretation of this section consistent with the purposes of the Constitution, Antitrust Laws and other provisions of the Patent Laws. Provisions such as 35 U.S.C. Sections 103 and 112 guide the Patent Office expert Examiners in establishing the extent of the patent grant by requiring the patentee to limit the scope of his claims to define only inventive subject matter. This initial determination is important because the claims in a patent are presumed valid. 35 U.S.C. Section 282.

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[8] Prestole Corp. v. Tinnerman Products, Inc., F.2d , 123 U.S.P.Q. 242, 249-50 (6th Cir. 1959); Electric Pipe Line, Inc. v. Fluid Systems, Inc., 231 F.2d 370 (2d Cir. 1956).

[9] A district court opinion, relying on cases and articles without referring to the legislative history, states that Congress intended to change the law of the *Mercoid* cases. *Sola Electric Co.* v. *General Electric Co.*, 146 F. Supp. 625, 647 (N.D. Ill. 1956).

4. Without an infringement, there can be no contributory infringement.[10] Therefore, the court below had to find that the individual owner of a licensed automobile who replaced his worn fabric with one sold by the Petitioners infringed the patent. This finding is in conflict with the *Morgan Envelope* case[11] decided by this Court. The latter case was referred to in testimony during Legislative Hearings on contributory infringement as holding that replacing worn or exhausted parts in a patented combination do not give rise to a cause of action for contributory infringement.[12]

The Court of Appeals erred in distinguishing this case by saying that the "element replaced by the defendants-appellants was a patented component of the Mackie-Dulin combination" whereas the oval toilet paper rolls in the *Morgan Envelope* case "were not patented elements of the devices there in suit". *Infra*, p. 28, n. 2. By calling the fabrics patented, the court below made a complete departure from the accepted and usual understanding that a part is not patented unless separately claimed in a patent.[13] In fact, the top fabrics here in suit were not patented, while the oval toilet paper rolls were patented, although the claim to the oval roll was held invalid.

Throughout the entire history of the patent, the top fabric itself was never claimed as an invention. The first

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[10] 35 U.S.C. § 271 (c) (1952); Cold Metal Process Co. v. United Engineering Co., 235 F.2d 224, 230 (3d Cir. 1956); Radio Corp. of America v. Andrea Corp., 79 F.2d 626, 627 (2d Cir. 1935).

[11] *Supra* note 5.

[12] *Contributory Infringement of Patents*, Hearings Before Subcommittee on Patents, Trademarks and Copyrights of the House Committee on the Judiciary, 81st Cong., 1st Sess., Ser. 17 at 20 (1950).

[13] See the *Mercoid* cases, 320 U.S. at 668 and "[A] patent on a combination is a patent on the assembled or functioning whole, not on the separate parts." at 320 U.S. 684.

time it was claimed as an invention was in a footnote of the Brief for Appellee filed in the Court of Appeals.[14]

The *Morgan Envelope* case recognized that the patentee was entitled to an initial royalty for the sale of the patented combination, but had no right to a royalty each time an element of the combination was replaced unless that element was itself a valid invention separately claimed. 152 U.S. at 432.

We know of no cases in courts of appeal where replacing a single unpatented worn element of a patented combination was held to be an infringement. Cases like the *Morgan Envelope* case in which the separate claim to the replaced element has been held invalid recognize that the owner of the patented combination can replace the worn element without paying the patentee an additional royalty.[15] We see no reason for giving greater rights to the patentee who does not and could not validly claim the convertible top fabric separately as an invention.

The decision in the case at bar, therefore, appears to be in conflict with courts of appeal decisions in the Second and Third circuits,[16] and in conflict with *Micromatic Hone Corp.* v. *Mid-West Abrasive Co.*, 177 F.2d 945 (6th Cir. 1949) and *Landis Machine Co.* v. *Chaso Tool Co.*, 141 F.2d 800 (6th Cir.), *cert. denied*, 323 U.S. 720 (1944). The latter case applied the reasoning of the *Mercoid* cases.

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[14] Brief for Appellee at 8.

[15] A claim to a hypodermic needle was held invalid and a claim covering a hypodermic syringe with the needle an element of the claimed combination was held not infringed by replacing worn needles. *Payne* v. *Dickinson*, 109 F.2d 52 (3d Cir.), *cert. denied*, 310 U.S. 637 (1940). A claim to a breaker arm in an automobile distributor was held invalid and a claim covering the electrical distribution system with the breaker arm as an element of the claimed combination was held not infringed by replacing worn breaker arms. *General Motors Corp.* v. *Preferred Electric & Wire Corp.*, 79 F.2d 621 (2d Cir. 1935), *cert. denied*, 296 U.S. 655 (1936).

[16] *Ibid.*

5. This case presents an important novel issue concerning the propriety of a patent owner shifting his patent rights among different corporations. So far as we know this is the first case where the owner of two combination patents covering the same structures (J.R.A. 32) has assigned a territorial grant limited to a single state under but one of the patents to a newly formed corporation just before the latter brings suit while continuing to receive royalties under both patents for the sale of replacements for worn parts in the patented combinations.

Although Automobile Body had before suit accused the Petitioners of contributorily infringing both the Mackie Duluk and Ackermans patents, a territorial grant in only the former was assigned to Respondent, Convertible Top. The assignment of a territorial grant in one patent alone to the Respondent corporation is in effect splitting a cause of action to create the possibility of piece-meal litigation, a practice long frowned upon by the courts.[17] In addition, formation of a shell corporation with no assets of value to institute suit under a territorial grant insulates the real parties in interest from even bearing court costs in the event the patent is held invalid. It is important that this Court prevent such manipulation of patent rights from establishing a precedent for other patentees.

6. The questions presented are of great importance in determining the rights of all types of replacement part manufacturers and dealers who make and sell replacement parts specially designed for use in patented combinations. The decision in this case is of specific importance in the automotive trade where many flourishing businesses de-

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[17] Panoualias v. National Equipment Co., 269 Fed. 630 (2d Cir. 1920), *cert. denied*, 256 U.S. 691 (1921); Horton v. New York Central H. R.R. Co., 63 Fed. 897 (N.D.N.Y. 1894). See also Helene Curtis Industries v. Sales Affiliates, 247 F.2d 940, 945 (2d Cir. 1957).

pend upon the right and ability to replace specific components of patented automotive devices.

7. The instant case is important in lending guidance to the lower courts in the proper use of legislative materials for statutory interpretation. Although the legislative history was presented to the Court of Appeals, this history was not mentioned in its opinion. An interpretation of paragraphs (b), (c) and (d) in Section 271 consistent with the purposes of Congress in enacting the Patent Laws and Antitrust Laws requires reference to the legislative history. Consideration of the following factors indicate that the court below was in error in interpreting the statute.

a. A broad statutory definition of contributory infringement was solicited by a private group critical of the *Mercoid* cases, the *Carbice* case, the *Leitch* case, and the *Morton Salt* case.[18] The responsible committee of Congress twice held hearings on this broad definition and twice refused to report bills with this broad definition.[19]

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[18] Carbice Corp. v. American Patents Dev. Co., 283 U.S. 420 (1931). Leitch Mfg. Co. v. Barber Co., 302 U.S. 458 (1938). Morton Salt Co. v. Suppiger, 314 U.S. 488 (1942).

For the critical comments, see *Contributory Infringement in Patents —Definition of Invention*, Hearings Before Subcommittee on Patents, Trademarks and Copyrights of the House Committee on the Judiciary, 80th Cong., 2d Sess.; ser. 21 at 3-6 (1948).

[19] Section 3 of the provisions on contributory infringement which Congress refused to enact read as follows:

> The sale of a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, if especially made or adapted for use in such process and not suitable for actual commercial noninfringing use, shall constitute contributory infringement. H.R. 3866, 81st Cong. 1st Sess. (1949); H.R. 5988, 80th Cong., 2d Sess. (1948).

In a memorandum from the subcommittee counsel to Congressman Bryson, the sponsor of the bill enacted into Title 35, these provisions were considered "too controversial" and counsel recommended that no action be taken on these provisions. A "watered down provision on the subject of contributory infringement" in H.R. 9133, 81st Cong.,

b. The original provisions were changed to narrow the definition of contributory infringement. In the original draft the sold component only had to be designed and intended for use in the patented combination and not suitable for actual commercial noninfringing use. This draft was changed to require that the sold component be "a material part of the invention" and "not suitable for substantial noninfringing use". The spokesman for the same private group explained what was meant by these changes to the responsible committee of Congress.[20] The real purpose of Section 271(c) was to prevent a seller of the invention from avoiding infringement by a technical interpretation of the patent claims.

c. Both the House and Senate Reports state that the statute is to codify principles of contributory infringement and that paragraph (c) is much more restricted than many proponents of contributory infringement believe should be the case.[21]

d. The scope of Section 271 ought to be interpreted within the framework of the Constitution which authorizes Congress to grant the inventor the exclusive right for a limited time to his discovery to promote the progress of science and the useful arts. We do not see how the Constitutional purposes are advanced by giving the inventor a limited monopoly to a part which is not his discovery merely because it is used in the combination which is his discovery.

2d Sess. (1950) was mentioned in this memorandum. Memorandum dated November 29, 1950 to Mr. Bryson from C. Murray Bernhardt. File on H.R. 3866 in National Archives.

[20] Hearings on H.R. 3760 Before Subcommittee on Patents, Trademarks and Copyrights of the House Committee on the Judiciary, 82nd Cong., 1st Sess., Ser. 9 at 154-57 (1951); Brief for Appellants at 63-65.

[21] S. Rep. No. 1979, 82d Cong., 2d Sess. at 9, (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess. at 8 (1952).

e. The scope of Section 271 should be interpreted within the framework of the Patent Laws which require the patentee to define his invention with particularity[22] (by claims) so that the expert Patent Office Examiner can search the prior art to see if the claimed subject matter represents an inventive departure over the prior art as required by 35 U.S.C. Section 103. The scope of Section 271 should also be determined within the framework of the Antitrust Laws and 35 U.S.C. Section 282 (1) recognizing unenforceability as a defense.

Congress has provided for the examination of patent applications by technical experts who search the prior art generally defined by the claims submitted by the applicant. If the claimed subject matter does not represent an inventive departure over the prior art uncovered on this search, the Patent Office refuses to grant a patent until the claims are amended to include limitations distinguishing the applicant's invention from the prior art.

If the invention claimed is a combination of elements, such as defined by the Mackie-Duluk patent claims, the Patent Office Examiner does not search the prior art to see if a single element, such as the top fabric of the claimed combination is an invention. The construction of Section 271 by the court below permits monopoly control over an element without even subjecting that element to the scrutiny of the Patent Office to determine whether the element is an invention.

[22] 35 U.S.C. §112 (1952).

Conclusion

For the foregoing reasons, this petition for a writ of certiorari should be granted.

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Appendix A

Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as in infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement. 35 U.S.C. §271.

Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section

102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. 35 U.S.C. §103.

Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most clearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. 35 U.S.C. §112.

ANTITRUST LAWS

Sec. 1. Every contract, combination in the form of trust or otherwise, or conspiracy, in restraint of trade or commerce among the several States, or with foreign nations, is hereby declared to be illegal. Every person who shall make any such contract or engage in any such combination or

conspiracy, shall be deemed guilty of a misdemeanor, and, on conviction thereof, shall be punished by fine not exceeding fifty thousand dollars, or by imprisonment not exceeding one year, or by both said punishments, in the discretion of the court. 69 Stat. 282, 15 U.S.C. §1.

Sec. 2. Every person who shall monopolize, or attempt to monopolize, or combine or conspire with any other person or persons, to monopolize any part of the trade or commerce among the several States, or with foreign nations, shall be deemed guilty of a misdemeanor, and, on conviction thereof, shall be punished by fine not exceeding fifty thousand dollars, or by imprisonment not exceeding one year, or by both said punishments, in the discretion of the court. 69 Stat. 282, 15 U.S.C. §2.

Sec. 3. Every contract, combination in form of trust or otherwise, or conspiracy, in restraint of trade or commerce in any Territory of the United States or of the District of Columbia, or in restraint of trade or commerce between any such Territory and another, or between any such Territory or Territories and any State or States or the District of Columbia, or with foreign nations, or between the District of Columbia and any State or States or foreign nations, is hereby declared illegal. Every person who shall make any such contract or engage in any such combination or conspiracy, shall be deemed guilty of a misdemeanor, and, on conviction thereof, shall be punished by fine not exceeding fifty thousand dollars, or by imprisonment not exceeding one year, or by both said punishments, in the discretion of the court. 69 Stat. 282, 15 U.S.C. §3.

Sec. 8. That the word "person", or "persons", wherever used in this act shall be deemed to include corporations and associations existing under or authorized by the laws of either the United States, the laws of any of the Territories, the laws of any State, or the laws of any foreign country. 26 Stat. 210 (1890), 15 U.S.C. §7.

Sec. 4: That any person who shall be injured in his business or property by reason of anything forbidden in the antitrust laws may sue therefor in any district court of the United States in the district in which the defendant resides or is found or has an agent, without respect to the amount in controversy, and shall recover threefold the damages by him sustained, and the cost of suit, including a reasonable attorney's fee. 38 Stat. 731, 15 U.S.C. §15.

Appendix B

United States Court of Appeals
For the First Circuit

No. 5488.

ARO MANUFACTURING CO., INC., ET AL.,
DEFENDANTS, APPELLANTS,

v.

CONVERTIBLE TOP REPLACEMENT CO., INC.,
PLAINTIFF, APPELLEE.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS.

Before MAGRUDER, *Chief Judge*, and WOODBURY and HARTIGAN, *Circuit Judges*.

David Wolf and *Charles Hieken*, with whom *Ezekiel Wolf*, *Wolf & Greenfield* was on brief, for appellants.

Elliott I. Pollock, with whom *Paul V. Power* was on brief, for appellee.

OPINION OF THE COURT.
August 31, 1959.

WOODBURY, *Chief Judge*. This is an appeal from an interlocutory judgment ordering, adjudging and decreeing that claims 3, 4, 5, 7, 8, 9 and 10 of United States Patent No. 2,569,724, issued on October 2, 1951, to Harry A. Mackie and Stanley Duluk for "Convertible Folding Top with Automatic Seal at Rear Quarter" are valid and have been infringed by the defendants, that the defendants, their officers, agents and servants be enjoined from further infringement, and that the question of the plaintiff's damages for past infringement be referred to a Master.

The plaintiff-appellee, Convertible Top Replacement Co.,

Inc., is the possessor by territorial grant of the right, title and interest in and to the Mackie-Duluk patent in and for the Commonwealth of Massachusetts together with all rights of action accruing since December 30, 1953, for infringement thereof in the Commonwealth. The defendants manufacture and sell, for replacement purposes only, the fabric portions of convertible tops which they either install themselves or sell pre-fabricated for installation by trimmers, that is to say, persons engaged in the business of putting on new tops, repairing upholstery etc., and, to an insignificant extent, to do-it-yourself car owners. The defendants' tops are custom-designed by make of car and year of manufacture to permit accurate replacements on all standard cars manufactured in the United States and are so advertised. They pre-fabricate and keep in stock the fabric parts only of convertible tops for various models of cars manufactured by the Ford Motor Company from 1952 to 1955, and for many models of General Motors cars manufactured for the years 1950 to 1954, when many convertible automobiles produced by those two manufacturers were equipped with Mackie-Duluk tops.

The District Court resolved the issue of the validity of the claims of the Mackie-Duluk patent in suit in favor of the plaintiff. It said: "Mackie-Duluk was a substantial and enlightened step, filling a long-felt want, in a field in which defendants have produced, with one exception, only paper patents, the most emphasized being foreign, which did not even purport to do what Mackie-Duluk accomplished." On this appeal, however, the question of validity has hardly been argued at all and we are not at all sure that all the evidence on that issue has been included in the parts of the record printed in the joint record appendix before us. Under these circumstances we can only take the validity of the patent claims in suit for granted

and turn immediately to the hotly contested issue of infringement.

The basic question argued before us on this appeal is whether the defendants, by manufacturing and selling replacement convertible top fabrics cut to fit and adapted for use in the combination of elements covered by the plaintiff's patent, are guilty of contributory infringement as defined in Title 35 U.S.C. § 271(c), or whether, in doing what they did, they merely were making a permissible replacement of a part which expectedly became worn out or defective sooner than other parts of the patented combination.

In addressing ourselves to this question we turn first to the patent in suit and its prior art.

Folding tops for vehicles consisting of bows of wood or metal covered with a flexible waterproof fabric (in the days of "The Deacon's Masterpiece; or, The Wonderful 'One-Hoss Shay'"[1] with leather) are, of course, as old as the automobile art which in the beginning only adopted with necessary modifications the much older art of collapsible tops for chaises, buggies and some other horse drawn vehicles. The rear panels of the folding tops of earlier days were fastened permanently at the bottom to the outside of the top of the rear portion of the body of the vehicle, and the quarters, the rear portions of the sides of the vehicle, if protected at all, were protected with flaps or curtains, sometimes integral with the top and sometimes not, fastened at the bottom to the outside of the top of the body with buttons, snaps or some equivalent means of fastening. Naturally, to prevent tearing, these quarter flaps had to be unfastened by hand when the top was lowered and when the top was put up fastened again by

[1] Poem by Oliver Wendell Holmes, 1857-1858:
"Boot, top, dasher, from tough old hide
Found in the pit when the tanner died."

hand for neat appearance and also to prevent the entrance of rain. This manual fastening and unfastening of the bottoms of the quarter flaps presented no great problem until the advent of the so-called convertible automobile with a folding top operated mechanically rather than manually. The problem presented by the quarter flaps of tops of this kind was first partially solved by fastening the bottom of the flap to the outside of the top of the body of the vehicle with "releasable fastening means," that is to say, with some sort of slide fastening device which would detach automatically when the top was lowered. The major part of the problem remained, however, for when the top was put up the flaps had to be fastened manually, which meant that the operator was required to get out of the car altogether, or at least to reach out, often, of course, in the rain. The object of the Mackie-Duluk patent was "to provide an automatic fastening and sealing means at the top and sides of the tonneau of the convertible" which "never has to be operated or touched by the driver of the car." And, as we have already indicated, the District Court found that the patentees succeeded in attaining their object by devising a patentable combination of elements.

The Mackie-Duluk device consisted of providing an elongated flap integral with the quarter sections of the fabric top adapted to be permanently fastened at the bottom deep within the body of the car, at or perhaps below, but certainly not in front, of the axis of rotation of the bows, to a trough welded to the body of the car and provided with a drain to carry off water entering between the flap and the car body. In addition, to minimize the entrance of water between the body and the flap, they provided a "wiper arm" so-called, which in effect acted as an additional, low, rearward bow pressing the downwardly extending flap outwardly against the top of the body of the vehicle as the top is raised from its folded position to close, a

substantially to close, any gap there might be between the inside of the top of the body of the car and the flap extending downward into the interior of the automobile body.

Claim 8 of the patent may be taken as typical of those in suit. It reads:

> "In a convertible automobile body, the combination of a lower metal body structure or tonneau having a body panel, a folding bow structure supported by the tonneau and having flexible top material supported by the bows and having the top material at the rear quarter extending down, a rain trough secured to the bottom of said flexible top material and to said panel on the inside and below the top of the metal body or tonneau, said flexible top material spreading and adjoining the inside of the top of the side of the tonneau when the bow structure is raised, and a wiping arm secured to a part of the movable bow structure and acting simultaneously with said bow structure to engage the inside lower portion of the top material in raising the top to press the two adjoining members toward each other and thereby produce a weather seal therebetween."

The defendants, as we have said, manufacture and sell only the fabric part of the convertible top structure. And from this they argue at length that, since fabric tops stretched over bows are admittedly very old in the vehicle art, they are only producing an unpatentable component of the combination covered in the patent in suit. If the argument were sound "there would be nothing to discuss," as the Court pointed out in *Heyer* v. *Duplicator Mfg. Co.*, 263 U.S. 100, 101 (1923). The argument, however, is unsound for the Mackie-Duluk patent does not broadly cover the fabric portion of a folding top of any form or shape.

It specifically covers the fabric part of such a top of a particular form or shape, *i.e.*, one with elongated flaps at the rear quarters designed to extend deep within the body of the convertible automobile for permanent attachment to a rain trough at or below the axis of rotation of the bows. It is true that the District Court found that it was not new to bring "the fabric from outside the tonneau at the rear quarters, inside." But it found that the patentees were the first to extend the flaps down far enough so that their bottom lines were at the axis of rotation of the bows and to show that there the fabric could be permanently attached to the bows and the tonneau without ripping when the top was lowered or raised, and that therein lay the patentable novelty of the patentees' fabric.[2]

Form being patentable in itself, see *Wilson* v. *Simpson*, 9 How. 108, 123 (1850), in which it is said: "Form may be given to a piece of any material,—wood, metal, or glass—so as to produce an original result, or to aid the efficiency of one already known, and that would be the subject for a patent," we come to the question whether the shape of the patentees' fabric constituted "a material part of the invention" within the meaning of that phrase as used in § 271(c) of Title 35 U.S.C., quoted in the margin.[3]

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[2] Since the element replaced by the defendants-appellants was a patented component of the Mackie-Duluk combination, the cases of *Morgan Envelope Co.* v. *Albany Paper Co.*, 152 U.S. 425, (1894), and *Micromatic Hone Corp.* v. *Mid-West Abrasive Co.*, 177 F.2d 934 (C.A. 6, 1949), upon which they rely, are not in point, for the elements replaced by the defendant in those cases, the roll of toilet paper and the abrasive stone, respectively, were not patented elements of the devices covered by the patents there in suit.

[3] Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer."

Reading this section in the light of the earlier decisions to be considered presently we do not think it could have been intended to prevent the rightful owner of a patented machine from making repairs to a broken, worn or defective part, even though covered by the patent, either himself or through someone other than the patentee. Nor do we think the section is to be read to prevent the owner of a patented machine from replacing from a source other than the patentee minor patented parts of a combination which in the normal use of the machine may be expected frequently to wear out or break and hence to require replacement at short intervals to keep the whole machine in working order and condition. That is to say, we think the rule stated and applied in *Wilson* v. *Simpson*, 9 How. 108 (1850), and *Heyer* v. *Duplicator Mfg. Co.*, 263 U.S. 100 (1923), is still the rule under Title 35 U.S.C. § 271(c).

In the *Wilson* case the Court held that the owner of a patented planing machine had the right to keep his machine in operation by replacing the patented cutting knives therein from sources other than the patentee, it appearing that the knives, although an essential element of the patented combination, could be expected in the normal use of the machine to wear out, become useless and require replacement at least every sixty or ninety days. In reaching this result the Court said at page 125:

> The right of the assignee [the owner of the machine] to replace the cutter-knives is not because they are of perishable materials, but because the inventor of the machine has so arranged them as a part of its combination, that the machine could not be continued in use without a succession of knives at short intervals. Unless they were replaced, the invention would have been but of little use to the inventor or to others. The other constituent parts of this invention, though liable

to be worn out, are not made with reference to any use of them which will require them to be replaced. These, without having a definite duration, are contemplated by the inventor to last so long as the materials of which they are formed can hold together in use in such a combination. No replacement of them at intermediate intervals is meant or is necessary. They may be repaired as the use may require. With such intentions, they are put into the structure. So it is understood by a purchaser, and beyond the duration of them a purchaser of the machine has not a longer use. But if another constituent part of the combination is meant to be only temporary in the use of the whole, and to be frequently replaced, because it will not last as long as the other parts of the combination, its inventor cannot complain, if he sells the use of his machine, that the purchaser uses it in the way the inventor meant it to be used, and in the only way in which the machine can be used."

In *Heyer* the question was whether the owners of certain costly and durable patented duplicating machines were entitled to replace from any source they chose the patented bands of gelatine used in the machines for transferring the print to be multiplied, which bands were of a size, were attached to spools adapted for, and were intended for use in the patented machine. In answering this question in the affirmative the Court specifically pointed out that while the machine might last indefinitely the bands were exhausted after limited use, about one hundred copies, and were "cheap and common articles of commerce." Reaffirming the *Wilson* case it said:

"The owner when he bought one of these machines had a right to suppose that he was free to maintain it

in use, without the further consent of the seller, for more than the sixty days in which the present gelatine might be used up."

And then the Court said that in cases of this sort the judicial function is "only to establish the construction of a bargain on principles of common sense applied to the specific facts."

When replacement of a patented component of a patented combination constitutes a legitimate repair and when it constitutes a forbidden reconstruction of the combination of which it forms a part is difficult to determine and cannot be determined by the application of any verbal formula. Each case must be decided on its own facts, pretty much as an individual instance. This court put the problem neatly and succinctly in *Goodyear Shoe Machinery Co.* v. *Jackson*, 112 Fed. 146, 150 (C.A. 1, 1901), wherein it is said:

"It is impracticable, as well as unwise, to attempt to lay down any rule on this subject, owing to the number and infinite variety of patented inventions. Each case, as it arises, must be decided in the light of all the facts and circumstances presented, and with an intelligent comprehension of the scope, nature, and purpose of the patented invention, and the fair and reasonable intention of the parties. Having clearly in mind the specification and claims of the patent, together with the condition of decay or destruction of the patented device or machine, the question whether its restoration to a sound state was legitimate repair, or a substantial reconstruction or reproduction of the patented invention, should be determined less by definitions or technical rules than by the exercise of sound common sense and an intelligent judgment."

Applying as best we can the "common sense" test of the case last cited and the *Heyer* case we conclude that the defendants were not making permissible repairs to, but were substantially reconstructing, the convertible top combination covered by the Mackie-Duluk patent. Couched in terms of the statute, we think they were making and selling a component of the plaintiff's patented combination "constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use."[4]

In substantiation of this conclusion we point out that the fabric portion of the top is not a minor or relatively inexpensive component of the patented combination, of a part of the invention which expectably would wear out after a very short period of use, like the cutter-knives in the *Wilson* case or the bands of gelatine in the *Heyer* case. There was testimony, and the court below found, that barring accidental damage the average life of a convertible top was about three years, although with care under favorable conditions or in the hands of a person not too fastidious as to appearance it would last much longer. The expectable life span of the fabric is no doubt shorter than the expectable life span of the other components of the convertible top and of the car itself. But the life of the

[4] The appellants do not establish that their prefabricated tops of which complaint is made are staple articles or commodities of commerce "suitable for substantial noninfringing use," and thus escape application of the statute, by pointing out that the tops it pre-fabricates for convertibles having the Mackie-Duluk structure can be applied in a noninfringing way by cutting off the flaps and putting on snap fasteners to cooperate with the snap fasteners on the outside of the top of the tonneau to hold the cover or boot customarily provided to cover the top and protect it from dust when the top is down. The fact remains that the appellants do not make tops for Mackie-Duluk equipped convertibles for application in the old fashioned prior art way but only in the way shown in the Mackie-Duluk patent.

fabric is not so short, nor is the fabric so cheap, that we can safely assume that an owner would rationally believe that in replacing it he was making only a minor repair to his top structure. On the contrary, we believe that replacing the fabric would be counted a major reconstruction of the top assembly. In short, we agree with the District Court's finding of infringement.

Other arguments advanced by the appellants have been considered but are rejected as too insubstantial to call for discussion.

Judgment will be entered affirming the judgment of the District Court.